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10/789,238

02/26/2004

Phillip L. Lam

PERFECT-1/CIP-2

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08/11/2006

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EXAMINER

MICHALSKI, SEAN M

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|----------------------------------------|--|
| Office Action Summary | Application No. 10/789,238 | Applicant(s) LAM, PHILLIP L. | |
| | Examiner Sean M. Michalski | Art Unit 3725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 10 recites the limitation "either direction" in line 6. There is insufficient antecedent basis for this limitation in the claim, since no two directions are recited. To have the recitation "either" there must be two alternate choices presented previously, which in this case there were not. In other words, the motion of the tool was in no way previously described so as to limit the available choices for its movement, and the recitation "either" is indefinite for a want of proper antecedent basis.

Obviousness Type Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5 ,7 , 9, 10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 ,7 , 9, 10 of copending Application No. 10/753,019. Although the conflicting claims are not identical, they are not patentably distinct from each other because 10/753,019 shows every element except a safety barrier, safety barriers adjacent blades are extremely well known and notorious in the cutting arts, see the safety barrier in Hanson (USPN 1,976,067).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 11 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 10/753,019 in view of Baltheiser, which shows a magnifying element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

5. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28, 30 or 31 of copending Application No. 10/753,019 in view of Baltheiser, which shows a magnifying element.

6. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of copending application 10/772,759. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because 10/772,759 shows every element except a safety barrier, safety barriers adjacent blades are extremely well known and notorious in the cutting arts, see the safety barrier in Hanson (USPN 1,976,067).

7. Claim 5 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 10/753,019 in view of claim 1 of copending application 10/772,759. Although the conflicting claims are not identical, they are not patentably distinct from each other because 10/753,019 in view of 10/772,759 shows every element except a safety barrier, safety barriers adjacent blades are extremely well known and notorious in the cutting arts.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3-5 is rejected under 35 U.S.C. 102(b) as being anticipated by Grisso (USPN 2,534,666).
2. Regarding claims 1 and 6, Grisso discloses an elongated member 13 with first and second ends (figure 1), a cutting member 4 (also end member 4) having an edge spaced apart from a safety barrier 5, there being a gap therebetween (figure 1).

3. Regarding claims 3 and 7, Grisso further discloses that the cutting member is removable.
4. Regarding claim 4, Grisso discloses a retention cap (8 figure 1).
5. Regarding claim 5, Grisso discloses that the second end comprises a pusher (the end on the far right of figure 1 is capable of pushing a cuticle and may be used therefor).
6. Regarding claim 8, Grosso discloses that the (first) end member (4) is detachable. Removing 9 and 8 will allow 4 the blade or end member to be removed.
7. Regarding claim 9, Grisso discloses a blade holding device (9 figure 1) having a blade receiving member 8 and being configured for releasable connection to a handle 13. the apparatus further contains a blade 4 having an edge (column 1 line 43) which can cut along any path of the users choosing including an arcuate or accurate path. There is a safety barrier 5, extending toward and around blade 4, but leaving a gap therebetween (column 1 lines 43-50).
8. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (USPN 1,976,067).

Hanson discloses a manicuring appliance with an elongated handle (20, 21 figure 2), having a detachable end portion (35 a and b figure 5; page 1 column 2 lines 95-107); said end portion having a blade formed from a flat metal sheet having an end region (near 35) folded over at an angle relative to the sheet, a pair of opposed blade edges (see figure 5) formed in the fold of said end region for cutting cuticle tissue while moving the end portion in many directions (page 2 column 1 lines 10-20). There is also

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disclosed a barrier (34) which is spaced apart from both cutting edges (seen in figure 4, there is a gap), the barrier (guard) so designed as to limit the depth of cutting into cuticle tissues (see page 2 column 1 lines 67-70). The description of element 34 as being a 'blade' does not detract from its identification as a guard (barrier).

9. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Baltheiser (USPN 6,367,482).

10. Regarding claim 12, Baltheiser discloses a manicuring appliance comprising an elongated handle 6 (6 is held by at least one hand) being transparent (column 5 lines 44-48) having at least one blade (seen clearly in figure 22) capable of cutting cuticle tissue. Baltheiser also discloses using a magnifier (13 figure 22) for better vision of the blade and nail.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rentz (USPN 5,464,029) in view of Baltheiser (USPN 6,367,482).

Rentz teaches a manicuring appliance comprising a magnifying lens and associated illuminating device configured for presenting an enlarged view of a users nail and the blade operating upon said user. See column 4 lines 29-30, and figure 1.

Rentz does not explicitly teach a cutting apparatus.

Baltheiser teaches a manicuring appliance comprising an elongated handle 6 (6 is held by at least one hand) being transparent (column 5 lines 44-48) having at least one blade (seen clearly in figure 22) capable of cutting cuticle tissue. Baltheiser also teaches using a magnifier (13 figure 22) for better vision of the blade and nail.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Rentz by using a cutting mechanism having specifics as taught by Baltheiser. The motivation to combine is that using the cutting tool of Baltheiser will allow for the automatic collection of nail clippings in conjunction with magnifying and illuminating of the nail.

Conclusion


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Papanikolao; Yusofov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMM



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER